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Paper No. 10

CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Green Bay Packers, Inc. and  
National Football League Properties, Inc.  
v.  
Marc A. Sebora

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Opposition No. 120,345  
to Application No. 75/246,847  
filed on February 24, 1997

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Robert Lloyd Raskopf, Claudia Bogdanos and Horace E.  
Anderson of White & Case for Green Bay Packers, Inc. and  
National Football League Properties, Inc.

David O. N. Johnson of Meyer, Puklich, Merriam & Johnson  
for Marc A. Sebora.

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Before Cissel, Walters and Drost, Administrative  
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Green Bay Packers, Inc. and National Football League  
Properties, Inc. filed their opposition to the

application of Marc A. Sebor to register the mark PACKARONI for "pasta" in International Class 30.<sup>1</sup>

Opposers assert several grounds of opposition. First, opposers assert that applicant's mark, when applied to applicant's goods, so resembles opposers' previously used and registered marks incorporating PACK and PACKERS for a variety of goods and services, including food products,<sup>2</sup> as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

Second, opposers assert that applicant is party to an agreement, dated April 30, 1998, wherein applicant agreed to refrain from filing any trademark application for the mark PACKERONI, or from using any marks containing trademarks of the NFL; that applicant expressly abandoned, with prejudice, its earlier application, Serial No. 75/189,565, for the mark PACKERONI for pasta products; and that, in consideration

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<sup>1</sup> Application Serial No. 75/246,847, filed February 24, 1997, based upon an allegation of a bona fide intention to use the mark in commerce in connection with the identified goods.

<sup>2</sup> Opposers plead four registrations: Registration No. 1,100,375, issued August 22, 1978 [renewed for term of ten years from August 22, 1998], in International Class 41, for the mark PACKERS; Registration No. 1,109,722, issued December 19, 1978 [renewed for a term of ten years from December 19, 1998], in International Class 41, for the mark GREEN BAY PACKERS; Registration No. 1,810,704, in International Classes 16 and 25, for the mark GREEN BAY PACKERS; and Registration No. 1,743,691, issued December 29, 1992, in International Class 41, for the mark AMERICA'S PACK GREEN BAY, USA and design.

thereof, opposers withdrew their Opposition No. 108,715 to registration of the PACKERONI mark.<sup>3</sup>

Third, opposers assert that applicant's mark falsely suggests a connection between applicant and opposers, under Section 2(a) of the Trademark Act, 15 U.S.C. 1052(a).

Finally, opposers assert that registration of applicant's mark will dilute the distinctive quality of opposers' famous PACKER marks, under Section 13(a) of the Trademark Act, 15 U.S.C. 1063(a).

Applicant, in its answer, denied the salient allegations of the claim and asserted unclean hands, laches, estoppel and acquiescence as affirmative defenses.

#### *The Record*

The record consists of the pleadings; the file of the involved application; and the testimony depositions by opposers of Marc A. Sebor, applicant, and David M. Proper, attorney for opposer National Football League Properties, Inc., with accompanying exhibits. Applicant submitted no testimony or evidence during its trial

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<sup>3</sup> While opposers do not assert a specific statutory basis for this ground of opposition, opposers argue in their brief that the application involved herein for the mark PACKARONI violates the terms of the above-referenced agreement between opposers and applicant.

period. Both parties filed briefs on the case but a hearing was not requested.

*Analysis*

Opposers submitted very little evidence in support of several of the grounds asserted in their notice of opposition. The testimony of Mr. Proper establishes that opposer Green Bay Packers, Inc. is a member club of the National Football League (NFL); that opposer National Football League Properties, Inc. (NFLP) is a business entity that has been the exclusive licensee of the NFL member clubs for trademark matters since 1963 and also licenses and enforces the various NFL trademarks; and that the Green Bay Packer team's licensed products sell well, particularly in connection with the team's participation in Super Bowl XXXI. Mr. Proper explained the nature of NFL licenses and sponsorships, noting that licensees pay a royalty and must use the trademarks of all teams equally, whereas sponsors pay a flat rate for the period of the contract and the trademarks used are specified in the contract. Mr. Proper stated that returns from these license and sponsor agreements total "hundreds of millions of dollars annually" (Proper, p. 13, ln. 21-23). Sponsors in the food industry include

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Campbell's Soup, Anheuser Busch, Miller, Quaker Oats, Gatorade, Coca Cola, Pepsi, General Mills, Hershey, Kraft and Oscar Meyer. Mr. Proper recalled a sponsor or licensee named The Pasta Shop in connection with pasta products in 1997-1998, but did not recall particular facts regarding the agreement. Mr. Proper stated that opposers have a number of broadcast partners; that the NFL team games are broadcast nationally and via the Internet; that licensed/sponsored goods are sold nationally; and that the various teams are promoted further through their involvement in community and charitable activities.

We note that there is reference in the testimony of both Mr. Proper and Mr. Sebor to "the Green Bay Packer trademarks"; however, opposers did not present any testimony or other evidence, such as status and title copies of registrations, establishing the status and title of the registrations asserted in the notice of opposition, or otherwise establishing opposers' ownership and use of any marks at common law, or the goods or services in connection with which such marks may be used or registered.

With their brief, opposers submitted numerous exhibits, including photocopies of certified copies of

several registrations. In his brief, applicant objected to opposers' brief in its entirety on the ground that it was untimely. Opposers point out, correctly, that their brief was filed in a timely manner.<sup>4</sup> However, the exhibits attached to opposers' brief are untimely because this evidence should have been filed during opposers' testimony period. Trademark Rule 2.142(d). Because this evidence is untimely, we have not considered these exhibits.

It is interesting that, in its brief, applicant concedes that opposers own the four trademark registrations asserted in the notice of opposition, namely, Registration No. 1,100,375 for PACKERS, Registration Nos. 1,109,722 and 1,810,704 for GREEN BAY PACKERS, and Registration No. 1,743,691 for AMERICA'S PACK GREEN BAY, USA and design.

It is even more interesting that opposers, in their reply brief, have correctly noted that applicant's brief was filed late and opposers' request that the brief be stricken. Because applicant's brief is untimely we grant

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<sup>4</sup> Opposers' brief was filed April 2, 2002, which is within the time for filing its brief based on opposers' consented motion to extend the testimony periods, which was filed October 5, 2001, and granted by the Board on November 13, 2001.

opposers' request and we have not considered applicant's brief.<sup>5</sup>

As a result of these procedural decisions, opposers are left with only the evidence and testimony presented at trial, which, as previously stated, does not establish opposers' ownership or use of any marks. Nor have opposers established facts necessary to prove the elements of their claims under Sections 2(a), 2(d), or 13(a).<sup>6</sup> Thus, the opposition must be dismissed as to opposers' Section 2(d) claim, which alleges priority and likelihood of confusion; opposers' Section 2(a) claim, which alleges that applicant's mark falsely suggests a connection between applicant and opposers; and opposers' Section 13(a) claim, which alleges that registration of applicant's mark will dilute the distinctive quality of opposers' famous PACKER marks.

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<sup>5</sup> Although we have not considered applicant's brief, applicant is not required to submit a brief. See 37 CFR §2.128(a)(1) and TBMP §801.02(b).

<sup>6</sup> To note one example - there is insufficient evidence that any marks that opposers may own are famous - only a conclusory statement by opposers' witness, Mr. Proper, and two cases cited by opposers in their brief, neither of which involve the Green Bay Packers: *National Football League Properties, Inc. v. New Jersey Giants, Inc.* (the court concluded that the NFL's marks were well known) (637 F. Supp. 507, 516 (D.N.J. 1986)); and *Johnny Blastoff, Inc. v. Los Angeles Rams Football Co.*, 188 F.3d 427, 434-435 (7<sup>th</sup> Cir. 1999) (case does not contain a specific conclusion that opposers' marks are well known). We do not find this evidence sufficient to either establish ownership, status or fame of their pleaded marks.

We turn now to opposers' claim that this application was filed in violation of an April 30, 1998 agreement between the same parties as opposers and applicant. In view of this agreement, Opposition No. 108,715 to application Serial No. 75/189,565, for the mark PACKERONI for pasta products, was dismissed with prejudice.

There is no question that the Board has jurisdiction over opposers' claim that applicant is in violation of the 1998 agreement. *Kimberly-Clark Corp. v. Fort Howard Paper Co.*, 772 F.2d 860, 227 USPQ 36 (Fed. Cir. 1985). Because no issues were actually litigated in the parties' prior Board proceeding, the applicability of the 1998 agreement to this proceeding is based upon claim preclusion. See *Chromalloy American Corp. v. Kenneth Gordon (New Orleans) Ltd.*, 736 F.2d 694, 222 USPQ 187 (Fed. Cir. 1984); *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1864 (Fed. Cir. 2000), reh'g and reh'g en banc denied, 2000 U.S. App. LEXIS 26699 (Fed. Cir. 2000); and *Flowers Industries Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1582 (TTAB 1987). As the Board stated in *Polaroid Corp. v. C & E Vision Services, Inc.*, 52 USPQ2d 1954, 1956 (TTAB 1999):

Our primary reviewing court, the Court of Appeals for the Federal Circuit, has stated that



it would be guided by the analysis set forth in the *Restatement (Second) of Judgments*, Section 24 (1982) in determining whether a plaintiff's claim in a particular case is barred by the doctrine of claim preclusion. See *Chromalloy American Corp. v. Kenneth Gordon (New Orleans) Ltd.*, 736 F.2d 694, 222 USPQ 187 (Fed. Cir. 1984). Section 24 of the Restatement describes the concept of a claim as follows:

(1) When a valid and final judgment rendered in an action extinguishes the plaintiff's claim pursuant to the rules of merger or bar ... the claim extinguished includes all rights of the plaintiff to remedies against the defendant with respect to all or any part of the transaction, or series of connected transactions, out of which the action arose.

(2) What factual grouping constitutes a "transaction", and what grouping constitutes a "series", are to be determined pragmatically, giving weight to such considerations as whether the facts are related in time, space, origin or motivation, whether they form a convenient trial unit, and whether their treatment as a unit conforms to the parties' expectations or business understanding or usage.

The Board, in applying the Restatement's analysis, has looked to whether the mark involved in the second proceeding is the same mark, in terms of commercial impression, as the mark involved in the first proceeding. See *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1894 (TTAB 1998).

Significant evidence and argument in this proceeding is directed to the 1998 agreement, which states in pertinent part:

[Applicant will not] (1) use the PACKERONI designation, or any other marks or designations containing any NFL trademarks, without the express written consent of National Football League Properties, Inc.; or (2) file any trademark application for the PACKERONI mark.

Opposers contend, essentially, that the mark in this application, PACKARONI, sounds the same as PACKERONI, looks very similar, with only one letter changed, and has the same commercial impression as the PACKERONI mark; that PACKARONI incorporates opposers' PACK mark; and that, therefore, applicant is in breach of the 1998 agreement.

As opposers have not submitted admissible evidence establishing their ownership of any trademarks in this proceeding, we clearly have insufficient evidence to find that the mark herein falls within the clause of the agreement prohibiting use of "any other marks or designations containing any NFL trademarks."

The only remaining prohibition in the agreement is against the use or registration of the PACKERONI mark or designation. Thus, we must determine whether the previously opposed mark and this mark are sufficiently similar for the claims in this proceeding to be considered part of a single transaction or a series of transactions within the *Restatement's* concept of a claim. Recognizing that the pronunciation is likely to be the same and that the marks differ by only one letter, we nonetheless find that the connotations and commercial

impressions are sufficiently different so that the claims involving these two marks cannot be considered to be part of a single transaction.<sup>7</sup> We find that the word PACKER is very apparent and dominates the mark PACKERONI, whereas PACKARONI appears to consist of two equally strong components - PACK and ARONI, which brings to mind "macaroni." Therefore, based on the record before us, we conclude that the 1998 agreement does not prohibit applicant's registration of PACKARONI for pasta. Opposers' claim in this regard fails.

*Decision:* The opposition is dismissed.

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<sup>7</sup> *Polaroid Corp. v. C & E Vision Services, Inc.*, *supra*. (POLAREX and design is not sufficiently similar to the same word, POLAREX, in typed form to be considered part of a single transaction). *Cf. Aromatique, Inc. v. Arthur H. Lang*, 25 USPQ2d 1359 (TTAB 1992) (claim preclusion applicable with regard to prior opposition because marks essentially identical where subject mark differs "ever so slightly in typeface and capitalization" from mark in prior application). In the *Aromatique* decision, the Board stated (at 1360): "[We do] not wish to encourage a losing party to modify its mark insignificantly after an adverse ruling and thereby avoid the estoppel effect of the prior adjudication." The case before us differs factually from the *Aromatique* case because, while the mark herein differs from the earlier mark by only one letter, the commercial impressions of the two marks are sufficiently different, as discussed above, so that a finding of claim preclusion is not appropriate.